

REMARKS

Claims 1 and 3-10 are pending in this application. By this Amendment, claims 1, 5, 6 and 7 have been amended to address informalities raised by the Examiner. Claim 6 has also been amended to recite the transition metal compound D) in the claim. No new matter has been introduced as a result of this Amendment.

Claim Objections

In response to the objections to claims 1 and 3-10, appropriate correction has been made, as suggested by the Examiner. Reconsideration and withdrawal of the Objection respectfully is requested.

Claim Rejections

Rejections Under 35 U.S.C. §112

A. Response to rejection of claim 6 under 35 U.S.C. 112, second paragraph.

In response to the rejection of claim 6 under 35 U.S.C. 112, second paragraph, Applicants have recited transition metal compound D) in the claim. Reconsideration and withdrawal of the Rejection respectfully is requested.

Rejections Under 35 U.S.C. § 103

B. Response to rejection of claims 1, 3, 4, 6 and 10 under 35 U.S.C. §103(a) as being unpatentable over Lynch et al.

In response to the rejection of claims 1, 3, 4, 6, and 10 under 35 U.S.C. 103(a) as being unpatentable over International Publication No. WO 02/098930 of Lynch et al. (“Lynch”), and its U.S. patent family, U.S. Patent No. 6,759,361, Applicants respectfully submit that a *prima facie* case of Obviousness has not been made out, and traverse the Rejection.

The U.S. Supreme Court in *Graham v. John Deere Co.*, 148 U.S.P.Q. 459 (1966) held that non-obviousness was determined under §103 by (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; (3)

resolving the level of ordinary skill in the art; and, (4) inquiring as to any objective evidence of non-obviousness. Accordingly, for the Examiner to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. See MPEP §2143. Finally, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. (BNA) 580 (C.C.P.A. 1974)

The Examiner has acknowledged that Lynch does not disclose the claimed sequence of contacting, which “require contacting the support such as silica with triethylaluminum prior to contacting of triethylaluminum and the boronic acid.” The Examiner nevertheless concludes that “the same final product would have been formed after both reactions are completed regardless of the contacting sequence of silica,” so that it would be obvious to a skilled artisan to prepare “a support cocatalyst by mixing silica, triethylaluminum and the boric acid in any sequence to provide a support cocatalyst and mixing the treated support with the metallocene complex to provide the supported catalyst since those mixing sequence is functionally equivalent.” Applicants respectfully disagree. The Examiner’s reasoning amounts to hindsight, using Applicants’ specification as a blueprint. This is not a proper showing of Obviousness under §103. Therefore a *prima facie* case of Obviousness has not been made out.

However, even if a *prima facie* case of Obviousness was made out, Applicants include with this Amendment data to overcome such a case. The accompanying Declaration by Dr. Bodo Richter summarizes testwork comparing polymerization catalysts produced using the method disclosed in Lynch, relative to that of the presently recited claims. In that testwork, a comparative polymerization catalyst was prepared by the method described in examples 1 and 2 of Lynch, using the amount and type of catalyst components of example 3 in the present application. Polymerizations were then conducted using the two catalysts. The data included in the Declaration demonstrate that the catalyst of example 3 of the present application is more active than the catalyst produced using the method of Lynch (9.8 kg PP/g-cat*hr versus 5.7 kg PP/g-cat*hr). Moreover, Figure 1 of the Declaration illustrates that the morphology of the polymer particles produced by the catalyst of example 3 of the present application is superior to that of the polymer particles produced by the catalyst of Lynch’s method, since the polymer of example 3 is finely divided without lump formation whereas the polymer of Lynch’s method has

lumps of various size. Therefore, the catalyst of example 3 of the present application is superior both in activity and morphology to that of Lynch, and Applicants respectfully submit that the Data represents a showing of criticality and unexpected results. Reconsideration and withdrawal of the Rejection respectfully is requested.

C. Response to rejection of claims 5, and 7-9 under 35 U.S.C. §102(b) as anticipated by or, in the alternative under 35 U.S.C. §103(a) as being obvious over Lynch.

In response to the rejection of claims 5, and 7-9 under 35 U.S.C. 102(b) as anticipated by or, in the alternative under 35 U.S.C. 103(a) as being unpatentable over Lynch, Applicants respectfully submit that, with respect to the rejection under 102(b), all the elements of the claims have not been made out, and that with the rejection under 103(a), that a *prima facie* case of Obviousness has not been made out, and traverse the rejection.

The Examiner has argued in the Rejection that the process used to prepare Lynch's catalyst is functionally equivalent to that of the instant claims, so that Lynch's cocatalyst and catalyst composition would inherently be the same as those of the presently recited claims. However, as described in paragraph B above, the Declaration by Dr. Bodo Richter clearly demonstrates that the cocatalyst and catalyst of the current claims is clearly different than that described in Lynch, possessing higher polymerization activity and producing polymer particles having superior morphology. Reconsideration and withdrawal of the rejection respectfully is requested.

Applicants respectfully request that a timely Notice of Allowance be issued in this case. Should the Examiner have questions or comments regarding this application or this Amendment, Applicants' attorney would welcome the opportunity to discuss the case with the Examiner.

The Commissioner is hereby authorized to charge U.S. PTO Deposit Account 08-2336 in the amount of any fee required for consideration of this Amendment.

This is intended to be a complete response to the Office Action mailed November 23, 2007.

Respectfully submitted,

William R. Reid

William R. Reid
Registration No. 47,894
Attorney for Applicant

I hereby certify that this correspondence is being deposited with sufficient postage thereon with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 19, 2008.

Philip A. Butta
May 19 2008

Date of Signature

Basell USA Inc.
Delaware Corporate Center II
2 Righter Parkway, Suite 300
Wilmington, DE 19803 USA
Attorney's Telephone No.: 302-683-8178
Attorney's Fax No.: 302-731-6408